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Reinhard Pinzer

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EXAMINER

BUCKLEY, AUDREA

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,377	Applicant(s) PINZER ET AL.	
	Examiner AUDREA J. BUCKLEY	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-46 is/are pending in the application.
- 4a) Of the above claim(s) 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-45 is/are rejected.
- 7) ☒ Claim(s) 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

Acknowledgement is made of Applicant's remarks/arguments filed 11/24/2009. Claims 24-45 are pending and under consideration herein.

Withdrawn Claim Rejections

The rejection of claims 24-27, 29-42, and 44 under 35 U.S.C. 103(a) as being unpatentable over Mondet (US 2004/0223990) as evidenced by Carbopol 1342 and Dow Corning 3225C specification sheets is withdrawn.

The rejection of claim 28 under 35 U.S.C. 103(a) as being unpatentable over Mondet (US 2004/0223990) as evidenced by Carbopol 1342 and Dow Corning 3225C specification sheets and further in view of Orrea (US 2003/0095936) is withdrawn.

The rejection of claim 43 under 35 U.S.C. 103(a) as being unpatentable over Mondet (US 2004/0223990) as evidenced by Carbopol 1342 and Dow Corning 3225C specification sheets and further in view of Patil et al. (US 2004/0213747) is withdrawn.

The rejection of claim 45 under 35 U.S.C. 103(a) as being unpatentable over Mondet (US 2004/0223990) as evidenced by Carbopol 1342 and Dow Corning 3225C specification sheets and further in view of Nichols et al. (US 6,509,009) is withdrawn.

Objections

Claims 30 is objected to because of the following informalities:
proofreading errors need editing. Appropriate correction is required.

Response to Arguments

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Applicant's arguments presented 11/24/2009 have been fully considered. As noted above, all rejections previously presented and not re-iterated herein are withdrawn. Applicant's positions against cited references are summarized and responded to as follows.

Applicants traverse the rejection of claims 24-27, 29-42, and 44 under 35 U.S.C. 103(a) as being unpatentable over Mondet et al. as evidenced by Carbopol 1342 and Dow Corning 3225C specification sheets. Applicants take the position that the Examiner's modification of Mondet to remove the exfoliated phyllosilicates would modify Mondet beyond its intended inventive use; Applicants cite *In re Gordon*. Applicants take the position that Mondet teaches away from the non-exfoliated intercalated phyllosilicate preparation of the present invention.

In response, this argument is not persuasive. The disclosure of Mondet et al. is directed to a cosmetic composition for caring for and/or making up the skin and/or lips in a physiologically acceptable medium. Mondet et al. does indeed include exfoliated phyllosilicates as advantageous additives for controlling texture, hold, and glossiness. Specifically, Mondet et al. teach that quaternary ammonium cations are known to convert hydrophilic phyllosilicates such as montmorillonites into organophilic phyllosilicates (see paragraph [0018]). Although the formulations of Mondet et al. utilize phyllosilicates, based on the whole disclosure of Mondet, the skilled artisan still reasonably would have expected continued success in skincare and makeup formulations not

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necessarily employing phyllosilicates. That is, the Examiner maintains that the proposed modification does not render the prior art unsatisfactory or inoperable for its intended purpose of making up or caring for the skin.

Further in response, it is pointed out that the instant claim language (i.e., “comprising”) does not in any way exclude phyllosilicates, or any fillers or thickeners, for that matter, from the claimed invention. Therefore, the applicability of the Mondet reference is maintained.

Secondly, Applicants argue that thousands of combinations [possible from the disclosure of Mondet et al.] lead to no predictable expectation of success towards the development of the instant invention; Applicants cite *In re O'Farrell*. Further, Applicants assert that when Mondet is taken as a whole, there is no suggestion that would predictably lead a person of ordinary skill in the art to the present invention as claimed.

In reply, it is noted that a conclusion of obviousness does not require absolute predictability, only a reasonable expectation of success i.e., a reasonable expectation of obtaining similar properties. However, since motivations for making specific substitutions/alterations were not specifically articulated in the outgoing rejection, Applicants arguments are considered persuasive.

Thirdly, Applicants assert that the conclusion of obviousness over Mondet is based on improper hindsight reasoning.

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In reply, the Examiner maintains that the combination of formulation components as in claim 24 was well within the level of ordinary skill in the art at the time the invention was made. However, it is the Examiner's position that a clear articulation providing the skilled artisan's motivation for combining these components was not set forth in the non-final office action of 5/26/2009, and it is for this reason that the rejection relying on Mondet has been withdrawn. It is noted that express, written motivation in the disclosure of Mondet to combine specific features of the invention is not required to demonstrate obviousness. A reliance on the ordinary skill in the art is proper for a showing of obviousness.

Finally and regarding the specific limitations of dependent claims 28, 43, and 45, Applicants iterate that, in conjunction with Mondet, the secondary references of Light, Patil, and Nicholas do not provide suggestion, motivation, or reasonable expectation of success in light of the arguments against Mondet as set forth above.

The relevance of the Mondet reference is maintained as articulated above, however rejections relying on this reference have been withdrawn for the reasons mentioned above.

New Grounds of Rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 24-27, 30-35, 37-42, 44, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reinhart et al. (US 2005/0118124 A1, filed Nov. 2004).

Regarding claims 24-27, 31-34, and 37-40, Reinhart teaches cosmetic emulsions comprising PEG/PPG dimethicone, silicone, lipid, and pigments (see Examples 4-5 (paragraphs [0318] and [0320]) and claims 32-33). Additionally, Reinhart teaches that the emulsions preferably comprise 0.1 to 95% water (see paragraph [0020]). For instance and regarding claims 24, 27, 34, and 37, Example 4 teaches cyclomethicone, dimethicone (volatile silicone), iron oxides (particulate substance), PEG/PPG-18/18 dimethicone, mica (a thickening agent), and silica (silicone oxide, a filler), among other components. See also claims 18, 34, and 35 of Reinhart regarding the filler and thickening agent required by instant claim 37.

Regarding claims 25, 26, 32, and 33, Example 5 teaches an emulsified form of the invention indicating that oil and water (a polar liquid) are present; Example 5, formulation 3 (concealer) includes cyclomethicone (a volatile silicone) in combination with dimethicone as well as candelilla wax (wax) and isopropyl isostearate (a lipid and vegetable oil). Example 5, formulation 2 (face powder) includes zinc stearate (an insoluble metal soap). As to claim 30, Reinhart claims hexamethyldisiloxane among the linear volatile silicone oils useful to the invention (see Reinhart claims 6 and 12). As to claim 31, Reinhart claims decamethylcyclopentasiloxane as the volatile silicone in a foundation makeup emulsion (see Reinhart claim 13). As to claim 35, the pigments utilized in

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Reinhart are in particulate and/or powder (finely divided) form (see Reinhart claim 12). As to claims 39 and 40, Reinhart teach the inclusion of a humectant (a care active). As to claim 41, Reinhart teaches an emulsion skincare composition having a viscosity ranging from about 5 to 1,000,000 centipoise (1 centipoise = 1 mPa) at 25°C (see Reinhart claim 47); similarly, Reinhart teaches that the skilled artisan can increase the viscosity of, or thicken, the composition by implementing "structuring agents" where desirable (see [0161]); it is noted that the process for measuring the viscosity is a product-by-process limitation, which lacks patentable weight, according to MPEP 2113. As to claim 42, Reinhart teach that the formulation may be water-in-oil or oil-in-water emulsions (see [0014]), for example creams, lotions, concealers, lipcolor, and the like, wherein other ingredients including film formers, thickeners, structuring agents, etc. may also be included (see [0020]); therefore, it would have been within the skill of the ordinary artisan to formulate an embodiment of the invention having pasty form.

Reinhart does not necessarily teach the instantly claimed features to be combined in a single embodiment of the invention, and for this reason, this rejection is made using obviousness rationale.

Similarly regarding claim 44, Example 4 teaches cyclomethicone (18.21%) and dimethicone (13.31%) (volatile silicones), PEG/PPG-18/18/dimethicone (27.21% for component) (emulsifier), triethoxycaprylylsilane (8.62% for component) (non-volatile silicone), mica (5.22%) and silica (0.34%) (thickeners), polyglyceryl-6-ricinoleate (27.21% for component) (lipid phase), and titanium

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dioxide (8.62% for component). As to claim 45, Reinhart teaches silica (suspension agent), preservatives (see Example 5, formulation 3); antioxidants (see [0299]-[0300]); fruit extract (flavoring) (see [0311]); chamomile flower extract (fragrance) (see [0311]).

Further regarding claim 44, Example 4 does not delineate the formulation components according to the same function-specific nomenclature as in the instant claim. Example 4 does not include 0.1 to 5% water. As to claim 45, Reinhart does not include all of the instantly claimed agents in a single embodiment of the invention.

However, as to claim 44, it is apparent to the skilled artisan that the instantly claimed ranges overlap or are similar enough to overlapping with the prior disclosure of Reinhart that one would have expected similar properties from a formulation resulting from routine optimization of the components. Further, although the formulation is anhydrous, it would have been within the skill of the artisan to implement water in order to create an emulsified form of the invention as taught by Reinhart (see [0014]). As to claim 45, it would have been obvious to the skilled artisan to incorporate the aforementioned active agents where their individually known effects were desired in the product (i.e., incorporate a fragrance in order to impart desirable fragrance to the product).

Regarding the instant claims, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to incorporate the aforementioned components in order to implement the known, associated

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results. For instance, it would have been obvious to the skilled artisan to implement pigments, thickeners, and emulsifying agents in order to provide desirable color, thickness, and physical stability in a lipstick formulation. Similarly, the skilled artisan would have found it obvious to incorporate a humectant into a topically applicable cream or paste in order to implement the known moisturizing properties associated with the humectant since these moisturizing properties are recognized to the skilled artisan to be beneficial to the skin.

One would have been motivated to do so to adjust the formulation properties in order to be suited for an intended cosmetic application, as is routine in the art and within the ordinary skill of the artisan. For instance, Reinhart teaches that lipsticks typically contain 0.01-99% oil, 0.1-50% structuring agent, and 0.1-50% of particulates, while creams and lotions, foundations, concealers, blushes, eyeshadows, and mascaras typically differ in their formulations as specified (see [0303]-[0308]); more specifically, Reinhart details the known roles of particular cosmetic components as articulated above. See MPEP 2144.05 regarding the patentability of formulations resulting from routine optimization procedures. Further, the skilled artisan would have been motivated to adjust the quantities of these components, as is routine in the art, in order to optimize the efficacy and physical properties of the product.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reinhart et al. (US 2005/0118124 A1, filed Nov. 2004) as applied to

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claims 24-27, 30-35, 37-42, 44, and 45 above, as evidenced by Peng and Tellefsen (“Bismuth Oxychloride- A Multifunctional Color Additive”, *Cosmetics & Toiletries Magazine*, Sept. 2003).

The teachings of Reinhart et al. are delineated above. It is noted that bismuth oxychloride (an inorganic pearlescent effect agent) is included in Example 5.

Peng et al. teach in *Cosmetics & Toiletries* magazine that bismuth oxychloride, as used in cosmetics, has luster effect properties.

Therefore, the formulations comprising bismuth oxychloride necessarily incorporate an effect agent as required by the instant claim.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reinhart et al. (US 2005/0118124 A1, filed Nov. 2004) as applied to claims 24-27, 30-35, 37-42, 44, and 45 above, and further in view of Light (US 2003/0095936).

The teaching of Reinhart is delineated above. Reinhart does not teach a silicone comprising a C8-C20 alkyl trimethicone.

However, Orrea discloses a lip gloss composition including one or more oils or oil-like emollients including laurytrimethicone (a C8-C20 alkyl trimethicone) (see paragraph [0019]).

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to modify Reinhart to include laurytrimethicone, since it is a silicone-based oil and the formulation in Reinhart includes silicone-

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based oils. See MPEP 2144.06 regarding the obviousness of combining/substituting equivalents known for the same purpose.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reinhart et al. (US 2005/0118124 A1, filed Nov. 2004) as applied to claims 24-27, 30-35, 37-42, 44, and 45 above, and further in view of Zanutto et al. (US 2005/0281850 A1, filed Sep. 2004).

The teaching of Reinhart is delineated above. Reinhart does not teach PEG/PPG-19/19 dimethicone.

However, Zanutto et al. teach topically applicable cosmetic/dermatological compositions comprising emulsions (see abstract, in particular). Zanutto et al. teach that silicone emulsifiers such as cyclopentasiloxane and PEG/PPG-19/19 dimethicone (sold under the name DC BY11-030 by Dow Corning) can be advantageously employed.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to substitute PEG/PPG-19/19 dimethicone as taught by Zanutto et al. for PEG/PPG-18/18 dimethicone as taught by Reinhart. Further, the skilled artisan would have noted the structural similarity of these two dimethicones, differing only by a polyethylene glycol/ polypropylene glycol subunit, and would have expected similar emulsifying activity from the PEG/PPG-19/19. One would have been motivated to incorporate this emulsifying agent in order to advantageously impart physical stability to the topically applicable formulation (see [0078] of Zanutto).

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reinhart et al. (US 2005/0118124 A1, filed Nov. 2004) as applied to claims 24-27, 30-35, 37-42, 44, and 45 above, and further in view of Patil et al. (US 2004/0213747)

The teachings of Reinhart are delineated above. Reinhart does not teach the preparation in the form of a thixotropic paste, however Reinhart does teach that the formulations can be in cream, lotion, or gel form (see paragraph [0302]).

However, Patil teaches montmorillonite materials hectorite and bentonite as thixotropic agents (see paragraph [0110]). Using this information plus the ordinary knowledge of the skilled artisan, the preparation in Reinhart can be in the form of a thixotropic paste.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to formulate the preparation in Reinhart as a thixotropic paste with a reasonable expectation of success since the preparation in Reinhart can contain a thixotropic agent and since Reinhart's teaching that the formulation can be in a cream, lotion, or gel form indicates that the formulation can be in the form of a paste.

Conclusion

No claims are found allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AUDREA J. BUCKLEY whose telephone

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number is (571)270-1336. The examiner can normally be reached on Monday-Thursday 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571) 272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sharmila Gollamudi Landau/
Supervisory Patent Examiner, Art Unit 1611